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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,743	03/31/2004	Jeffrey D. Ollis	BCS03153	7191
43471	7550	07/01/2008	EXAMINER	
Motorola, Inc. Law Department 1303 East Algonquin Road 3rd Floor Schaumburg, IL 60196			LASHLEY, LAUREL L	
			ART UNIT	PAPER NUMBER
			2132	
			NOTIFICATION DATE	DELIVERY MODE
			07/01/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.Schaumburg@motorola.com
APT099@motorola.com

Office Action Summary

Application No.

10/814,743

Applicant(s)

OLLIS ET AL.

Examiner

LAUREL LASHLEY

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendments with respect to still pending claims 8-21 filed 03/03/2008 have been accepted and entered. The 112, second paragraph rejection is withdrawn in view of cancelled claims 1-7.

Response to Arguments

2. Applicant's arguments filed 03/03/2008 have been fully considered but they are not persuasive. It is Applicant's argument that Nurmman does not analyze the format of any received IP address to then decide if it should perform an action as required by the claim limitations. The Examiner respectfully disagrees. Nurmman discloses that an IP address of an IP host is examined to determine if specific criterion are met before configuration procedures are established (see column 3, lines 30-34). Furthermore, Nurmman discloses that the IP addresses are prepared for allocation and configuration (see column 4, line 51- column 5, line 5). The Examiner believes this preparation for allocation and configuration requires examination of the IP address. For at least these reasons the Examiner maintains the rejection of claims 8-21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15, 16, 18 and 19 rejected under 35 U.S.C. 102(e) as being anticipated by Nurmman, U.S. Patent No. 6,560,642.

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As per claims 8 and 10-14:

Nurmann discloses a method (20) for automatically self-configuring a network device being added to a network comprising:

attempting (21) to access a NAT, DHCP or DNS service from the network, which NAT, DHCP or DNS service is also capable of being performed by the network device (4:36-50, claim 2);

upon (24) successfully accessing the DHCP service by the network device, disabling the NAT, DHCP or DNS service within the network device (2:43-67, claim 2); and

upon (23) unsuccessfully accessing the DHCP service by the network device, activating the NAT, DHCP or DNS service within the network device (2:43-67, claim 2);

acquiring (31) an Internet Protocol address from the network (4:51-5:5);

determining (32) if the Internet Protocol address assigned by the network is a private Internet Protocol address (4:51-5:5); and

upon (34) determining that the assigned Internet Protocol address is a private Internet Protocol address, self-configuring the network device to use a local area network port to access the Internet and the network (4:51-5:5).

As per claims 15, 16, 18 and 19:

Nurmann further discloses a method (30) for automatically self-configuring a network device being added to a network comprising:

acquiring (31) an Internet Protocol address from the network; and

self-configuring (33) the network device to act as a gateway to the Internet for the network based on a format of the Internet Protocol address wherein the format includes an address type and wherein the address type includes a private Internet Protocol address and the address type includes a format that matches 10.x.x.x (4:51-5:5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 17, 20 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Nurmman in view of Kim, U.S. PG-PUB 2003/0214955.

As per claims 9 and 17:

Nurmman fails to teach determining a public Internet Protocol address assigned to the network device and then self-configuring the network device to use a wide area network port to access the Internet and a local area network port to access the network. However, Kim discloses assigning a public Internet Protocol address to a network device and configuring the device to access the Internet through a wan port and the network through a lan port (paragraph 0008).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the known technique of assigning public IP addresses as disclosed in Kim, with the invention of Nurmman in order to yield the predictable result of determining whether the network device is needed to function as a gateway.

As per claims 20 and 21:

Nurmman substantially teaches a method (20) for automatically self-configuring a network device being added to a network comprising:

attempting (21) to access a NAT, DHCP or DNS service from the network, which NAT, DHCP or DNS service is also capable of being performed by the network device (4:36-50, claim 2);

upon (24) successfully accessing the DHCP service by the network device, disabling the NAT, DHCP or DNS service within the network device (2:43-67, claim 2); and

upon (23) unsuccessfully accessing the DHCP service by the network device, activating the NAT, DHCP or DNS service within the network device (2:43-67, claim 2);

acquiring (31) an Internet Protocol address from the network (4:51-5:5);

determining (32) if the Internet Protocol address assigned by the network is a private Internet Protocol address (4:51-5:5); and

upon (34) determining that the assigned Internet Protocol address is a private Internet Protocol address, self-configuring the network device to use a local area network port to access the Internet and the network (4:51-5:5).

Nurmann fails to teach determining a public Internet Protocol address assigned to the network device and then self-configuring the network device to use a wide area network port to access the Internet and a local area network port to access the network. However, Kim discloses assigning a public Internet Protocol address to a network device and configuring the device to access the Internet through a wan port and the network through a lan port (paragraph 0008).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the known technique of assigning public IP addresses as disclosed in Kim, with the invention of Nurmann in order to yield the predictable result of determining whether the network device is needed to function as a gateway.

Conclusion

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAUREL LASHLEY whose telephone number is (571)272-0693. The examiner can normally be reached on Monday - Thursday, alt Fridays btw 7:30 am & 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laurel Lashley
Examiner
Art Unit 2132

/L. L./
05/29/2008

/Gilberto Barron Jr/
Supervisory Patent Examiner, Art Unit 2132